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JAN 31 2003

TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No.
Y2K.0090

In Re Application Of: Michael Nowak

Serial No.
09/705,411

Filing Date
November 2000

Examiner
James M. Hewitt

Group Art Unit
3628

Invention: MULTIPURPOSE ADVERTISING DEVICE

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:
December 3, 2002

Applicant is a small entity under 37 CFR 1.9 and 1.27.

A verified statement of small entity status under 37 CFR 1.27:

- ☐ is enclosed.
- ☒ has already been filed in this application.

The fee for filing this Appeal Brief is: **\$160.00**

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Applicant(s): Michael Nowak

Docket No.

Y2K.0090

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Examiner

James M. Hewitt

Group Art Unit

3628

Invention:

MULTIPURPOSE ADVERTISING DEVICE

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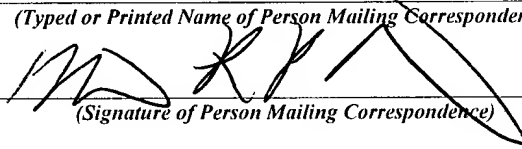
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PRIMARY EXAMINER

Inventor: Michael Nowak)
Title: MULTIPURPOSE ADVERTISING DEVICE)
Serial Number: 09/705,411)
Filing Date: November 3, 2000)
Attorney's Docket Number: Y2K.0090)

Group Art Unit:
3628

Examiner:
James M.
Hewitt

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

BRIEF ON APPEAL

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APPEAL SUMMARY

Appellant hereby appeals the Final Rejection of Claims 1 to 12. Said final rejection was dated August 6, 2002. The time for response to the final rejection was extended by fax to December 6, 2002. A proper notice of Appeal was filed by fax on December 3, 2002. Due to express mailing, the enclosed Brief on Appeal in triplicate has an effective filing date of on or before February 3, 2003, and is timely. A check for \$160.00 is enclosed to cover the fee for filing the brief, along with appropriate deposit account authorizations.

REAL PARTY IN INTEREST

The inventor is the real party in interest.

RELATED APPLICATIONS

There are no related applications.

STATUS OF CLAIMS

Claims 1 to 12 are in the application. Claims 1 to 12 are on appeal. Claims 1 to 12 stand rejected under 35 U.S.C. 102 as anticipated by U.S. Patent Number 5,487,568 to Ipsen (hereafter Ipsen).

STATUS OF AMENDMENTS

The amendment after Final filed by fax on October 31, 2002, was entered pursuant to a communication from the Examiner, leaving only a rejection under 35 U.S.C. 102.

SUMMARY OF THE INVENTION

The invention is clearly summarized on Page 4, Lines 2 to 8 as: "(A)n advertising device (is) in the form of a generally rectangular plate. Around the plate is a frame. Within the frame, thereby completing the plate, is a center section adapted to be punched out or removed from the frame as desired. The frame contains the necessary apertures for securing the device to a vehicle with or without a center portion."

ISSUES

The main issue on appeal is the application of U.S. Patent Number 5,487,568 to Ipsen (hereafter Ipsen) to the instant claims. This reference has been applied to the pending Claims 1 to 12 under 35 U.S.C. 102. The response after final rejection was indicated to satisfy and remove objections under double patenting.

GROUPING OF CLAIMS

Claims 1 to 12 are in the application and on appeal. Claims 1 to 12 are on appeal. Claims 1 to 12 stand rejected under 35 U.S.C. 102 as anticipated by Ipsen. Appellant asks the Board of Appeals to reverse the Examiner's decision.

A R G U M E N T

Appellant has developed an advertising device in the form of a generally rectangular plate. Around the plate is a frame. Within the frame, thereby completing the plate,

is a center section adapted to be punched out or removed from the frame as desired. The frame contains the necessary apertures for securing the device to a vehicle with or without a center portion. The cited reference does not discuss the problems suggested by appellant, and clearly cannot suggest appellant's solutions to those problems.

The Ipsen Patent Rejection

Claims 1 to 12 stand rejected under 35 U.S.C. 102 as anticipated by Ipsen. In this rejection, the Examiner erroneously describes Ipsen to disclose:

"an advertising device adapted for mounting on a vehicle, the device comprising a frame (16/17) and a center section (15) forming the advertising device; the device being adapted for securing to a license plate area of a vehicle; the frame being securable to the vehicle; the frame and the center section being adapted to have advertising thereon; and the frame being separable from the center section."

This is an incorrect, and far from precise, description of the Ipsen structure, especially based on the problem this reference must solve.

Perusing Ipsen, at Col 1, lines 15 et seq., Ipsen clearly defines the problem he deals with as follows:

"Federal law, for example, requires car dealers to display a form known as a 'Buyers Guide' on windows of

used cares before offering the cars for sale. These forms are two-sided and are typically adhesively attached to a window so that the information entered by the dealer on both sides of the form is readily visible to a buyer. The law also requires that the dealer give the buyer the original 'Buyers Guide' (or accurate copy) that was displayed on the vehicle."

There is no advertising disclosed nor is securement to a license plate area suggested.

One would be hard pressed to read a "back side" of a federally required form if it were mounted in a license plate area.

Ipsen, to solve his problem provides a two-sided form having an adhesive bearing, blank peripheral strip for attachment to a windshield so both sides of the form can be read. The form is removable from within the adhesive peripheral strip because of serrations provided between the form and the strip. There is no frame and as stated above, mounting Ipsen's device in the license plate area defeats the entire purpose of Ipsen.

Thus, not only has the Examiner misconstrued Ipsen, but he has also failed to view Ipsen's "teachings as a whole".

Thus, the Ipsen structure is substantially different from the structure provided by appellant and therefore cannot anticipate the claimed invention. Ipsen relates to a

tablet, or two sided sheet, which can be adhered to the windshield of vehicle in a manner so that both sides of the tablet or sheet are simultaneously visible. Ipsen relates to the necessity of simultaneous, dual surface visibility of a document required by law, does not mention let alone deal with license plates and thus does not even recognize the problem appellant addresses, let alone appellant's solution thereto. To use the Ipsen device in the manner and for the purpose taught by applicant is a physical impossibility.

In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990) teaches that:

"`For a prior art reference to anticipate in terms of 35 U.S.C. Section 102, every element of the claimed invention must be identically shown in a single reference'...These elements must be arranged as in the claim under review,..."

It is well set forth in the specification that appellant's advertising device is positioned on a vehicle in the license plate area. While the vehicle is still on the sales lot at a dealer, appellant's device is left whole. When the vehicle is sold, the advertising device is separated into the frame and center portion by breaking all tabs holding the center portion on the frame. Any number of suitable tabs may be used to hold the advertising device together. When it is desired to place a license plate on the vehicle, the center portion is separated from the frame

in a fashion so that the frame of appellant's device may be left around a license plate on a vehicle the frame also carrying advertising thereon.

Nowhere does appellant address Ipsen's problem and nowhere does Ipsen address appellant's problem.

Accordingly, appellant's claims are believed allowable and reversal of this rejection are respectfully requested.

Appellant's problem, together with his solution and its advantages are undisclosed, unsuggested and completely lacking from Ipsen. This lack brings this application into the realm of In re Antoine, 559 F2d 618,619; 195 USPQ 6,8 (CCPA 1977), and renders the reference inapplicable to the instant claims.

Appellant's advantages are clearly disclosed, plainly discussed and heavily emphasized in appellant's claims and specification. These factors bring this application into the realm of In re Benno, 226 USPQ 683 (Fed. Cir. 1985).

"In dismissing Dante as a reference, the court pointed out that Dante did not even hint at the problem the appellants sought to solve. Dante would not even have encountered the problem because it would not have appeared in what he was doing."

And for a similar decision U. S. v. Adams, 383 U.S. 39, 48-49; 148 USPQ 479, 482 (1966), includes the following interpretation of the patent law:

"Novelty and nonobviousness, as well as utility, are separate tests of patentability. All must be satisfied in a valid patent.

"While patent claims limit invention, and specification cannot be utilized to expand patent monopoly, claims are construed in light of specification and both are read with a view to ascertaining the invention."

These factors further indicate render that the Ipsen reference is inapplicable to the instant claims.

Additionally, the Board's attention is directed to the decisions in:

Structural Rubber Prod. Co., v. Park Rubber Co., 749 F.2d 707, 223 USPQ 1264 (Fed. Cir. 1984).

"Anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. Anticipation is not shown even if the differences between the claims and the prior art references are 'insubstantial' and the missing elements could be supplied by the knowledge of one skilled in the art."

And in In re Bond, 910 F.2d 831, 15 USPQ2D 1566 (Fed. Cir. 1990), the defects of the Ipsen reference as applied to appellant's invention are further emphasized.

"For a prior art reference to anticipate in terms of 35 U.S.C. Section 102, every element of the claimed invention must be identically shown in a single reference. These

elements must be arranged as in the claim under review,.....

These decisions support applicants' contention that the Examiner's opinion lacks a solid evidentiary base.

Accordingly, reversal of this rejection is requested:

APPENDIX

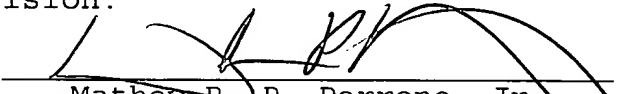
The appendix contains a COPY OF THE CLAIMS on appeal.

ORAL HEARING

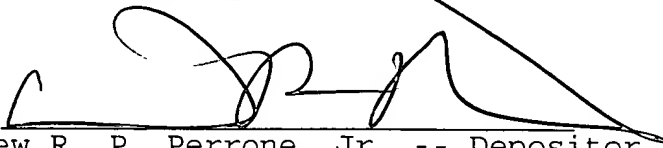
Appellant waives the oral hearing.

CONCLUSION

Having thus responded to the rejections by the Examiner, appellant respectfully requests reversal of the Examiner's decision.


Mathew R. P. Perrone, Jr.

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Mathew R. P. Perrone, Jr. -- Depositor

Mathew R. P. Perrone, Jr.
Attorney for Appellant
210 South Main Street
Algonquin, Illinois 60102
Telephone Number: 847/658-5140
Registration Number: 22,951

Date of Filing: on or before February 3, 2003.

APPENDIX OF CLAIMS ON APPEAL

Claims 1 to 12 are the claims on appeal. The claims, including all permitted amendments, are as follows in order of dependency.

Claim 1 (once amended). An advertising device adapted for mounting on a vehicle comprising:

- (a) a frame and a center section forming the advertising device;
- (b) the advertising device being adapted for securing to a license plate area of a vehicle;
- (c) the frame being securable to the vehicle;
- (d) the frame and the center section being adapted to have advertising thereon; and
- (e) the frame being separable from the center section.

Claim 2. The advertising device of Claim 1 wherein:

- (a) the advertising device has at least one slit separating the center portion from the frame;
- (b) the advertising device has at least one tab connecting the center portion to the frame;
- (c) the at least one tab is capable of being severed in order to separate the center portion from the frame;
- (d) the at least one slit and at least one tab provides a shape for the center portion relative to the frame.

Claim 3. The advertising device of Claim 2 wherein:

(a) the frame separates from the center portion by severing all members of the class consisting of the at least one tab; and

(b) the frame includes at least one aperture for securing the advertising device to the vehicle.

Claim 4. The advertising device of Claim 3 having a generally rectangular shape.

Claim 5. (once amended) The advertising device of Claim 2 wherein:

(a) the frame separates from the center portion by severing all members of the class consisting of the at least one tab; and

(b) the frame including at least one aperture for securing the frame to the vehicle.

Claim 6. The advertising device of Claim 5 having a generally rectangular shape.

Claim 7. In a vehicle having at least one advertisement thereon, the improvement comprising an advertising device with the at least one advertisement thereon adapted for mounting on the vehicle, the improvement further comprising:

(a) the advertising device having a multiplicity of uses;

(b) the advertising device including a frame and a center section;

(c) the advertising device being adapted for securing to a license plate area of a vehicle;

(d) the frame being securable to the vehicle;

(e) the frame and the center section being adapted to have advertising thereon; and

(f) the frame being separable from the center section.

Claim 8. The vehicle of Claim 7 wherein:

(a) the advertising device has at least one slit separating the center portion from the frame;

(b) the advertising device has at least one tab connecting the center portion to the frame;

(c) the at least one tab provides for severing the center portion from the frame; and

(d) the at least one slit and the at least one tab provides a shape for the center portion relative to the frame.

Claim 9. The vehicle of Claim 8 further comprising:

(a) the frame separating from the center portion by severing all members of the class consisting of the at least one tab; and

(b) the frame including at least one aperture for securing the advertising device to the vehicle.

Claim 10. The vehicle of Claim 9 having a generally rectangular shape.

Claim 11. The vehicle of Claim 8 further comprising:

(a) the frame separating from the center portion by severing all members of the class consisting of the at least one tab; and

(b) the frame including at least one aperture for securing the frame to the vehicle.

Claim 12. The vehicle of Claim 11 with the advertising device having a generally rectangular shape.